

REMARKS

In response to the Office Action dated May 5, 2004, and in view of the Request for Withdrawal of the Finality of the previous Office Action under 37 C.F.R. 1.129 filed herewith, Applicant respectfully requests entry of the present amendment and consideration of the comments herein. Applicant notes with appreciation the indication of allowance of claims 6, 8, 10, 11, 18-20 and 22.

Prior to this Amendment, claims 6, 8, 10-12, 14, 18-20 and 22-38 were pending. By this amendment, claims 12, 14, 27-30 and 35-38 have been cancelled. Accordingly, claims 6, 8, 11, 18-20, 22-26 and 31-34 are pending for consideration in the present application, of which claims 6, 8, 11, 18, 19, 27, and 31 are independent.

On page 2 of the Office Action, the Information Disclosure Statement of April 5, 2004 is indicated as failing to comply with 37 C.F.R. 1.98(a)(2). Applicant, however, respectfully submits that on April 22, 2004, an Information Disclosure Statement was filed providing the documents missing from the Information Disclosure Statement filed April 5, 2004. However, since it appears that the documents have been misplaced or were not provided to the Examiner prior to issuance of the last Office Action, Applicant has provided duplicate copies of the documents. Consideration of these references is again requested. A clean PTO Form 1449 is attached for the Examiner's convenience.

Also on page 2 of the Office Action, the Examiner objects to the disclosure as containing minor informalities, e.g., indicating that FIG. 1 is missing. Applicant assumes that since this objection is only now being applied, that FIG. 1 was misplaced by the Office. Accordingly, Applicant provides herewith a copy of FIG. 1, labeled "Replacement Sheet." Additionally, Applicant provides a copy of the Official filing receipt where the Office initially indicated receipt of one figure (FIG. 1). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection.

The Office Action also objects to claim 14 as containing informalities. Applicant respectfully submits that the cancellation of this claim renders this objection moot. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 23, 27 and 35 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, regarding claim 23, the Office Action indicates that the phrase "along which a superconducting carrier flows" does not

appear in the original specification and thus is new matter. Moreover, regarding claims 27 and 35, the Office Action indicates that there is no support in the specification for the critical temperature being no lower than 70 K. In view of the amendments above and comments to follow, Applicant respectfully traverses this rejection.

Applicant submits that the rejection of claims 27 and 35 is rendered moot by the cancellation of these claims. Regarding the phrase “along which a superconducting carrier flows”, Applicant submits that, contrary to the assertion made in the Office Action, at page 6, lines 18-21, the phrase “...superconductivity results from the electrons in the layer-like structure which is formed by the four oxygen atoms surrounding each central copper atom 3” is adequate for support in the specification. In addition, support may also be found on the last line of the third paragraph from the bottom of page 7 of the verified translation of the priority document (Japanese Patent Application No. 62-724483). The verified English translation is submitted in related Application Serial No. 07/492,858 (filed March 3, 1990).

The Office Action indicates that the above-noted portion of the specification does not support the claimed generic teaching. Applicant notes that MPEP 2163.02 states that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” Since the exact same terms are not required for the written description requirement, Applicant submits that the above noted disclosure is sufficient. However, if this rejection is maintained, Applicant respectfully requests further explanation regarding the rejection.

On page 3 of the Office Action, claims 12 and 23-38 are rejected under 35 U.S.C. 102(e) as clearly anticipated by Batlogg et al. (U.S. Patent 6,638,894; U.S. Patent 6,635,603; or, U.S. Patent 6,630,425 – all of which are referred to as Batlogg hereafter). Further, claim 14 stands rejected under 35 U.S.C. §103(a) as unpatentable over Batlogg et al. ('894 or '603). These rejections are respectfully traversed at least for the reasons provided below.

Applicant notes that claims 14, 27-30 and 35-38 have been cancelled and asserts that the rejection of the claims is now rendered moot.

Moreover, regarding the rejection of claims 23-26 and 31-34, Applicant respectfully submits that this rejection is improper. Initially, Applicant notes that the Office Action admits that these patents do not teach that superconducting carrier flows along said two layers as variously recited in the claims. Moreover, the Office Action indicates that one of ordinary


skill in the art would expect the superconducting carrier to flow along the copper oxide layers. Applicant submits that, the rejection under 35 U.S.C. 102(e) is improper since each and every element of the rejected claims are not provided in the cited references. Therefore, the references cannot anticipate the recited invention as required under 35 U.S.C. 102. If this rejection is maintained, Applicant requests that the next Office Action specifically point out and indicate the portions of each Batlogg patent that allegedly disclose the claimed invention as variously set forth in claims 23-26 and 31-34. Moreover, Applicant submits that a 35 U.S.C. 103(a) rejection is not warranted since there is no teaching or suggestion that the materials disclosed by the cited references could be modified to include the claimed structure variously set forth in claims 23-26 and 31-34. Specifically, Applicant can find no disclosure, within any of the Batlogg patents, of anisotropy of superconducting ceramics. Accordingly, Applicant requests reconsideration and withdrawal of the rejection.

On page 4 of the Office Action, claims 23-25, 27-29 and 31-38 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 8-10 and 15-22 of copending application No. 07/859,254. Also, claims 26 and 30 are provisionally rejected under the judicially created doctrine of double patenting of the same copending application. Applicant requests that this rejection be held in abeyance until indication that all claims are otherwise allowable.

Having responded to the rejection set forth in the outstanding Office Action, it is submitted that claims 6, 8, 11, 18-20, 22-26 and 31-34 are now in condition for allowance.

In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is courteously requested to contact Applicant's undersigned representative.

Respectfully submitted,

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